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UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
_____

Ex parte SHELL S. SIMPSON, WARD S. FOSTER,
and KRIS R. LIVINGSTON
_____

Appeal 2009-005561
Application 10/059,083[1]
Technology Center 2400
_____

Decided: January 29, 2010
_____

Before JOHN C. MARTIN, MARC S. HOFF,
and CARL W. WHITEHEAD, JR., *Administrative Patent Judges.*

HOFF, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-24. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention concerns a printing system including a computer and a printer, wherein the user requests that when an event such as a print failure occurs that the printer system will transmit a message to the user when pre-determined criterion are met, such as notifying the user between the hours of business (Abstract, Fig. 7, 1:1-10, 8:8-9:6).

Claim 1 is exemplary:

1.   A method of transmitting a message, the method comprising:
        determining if a device encounters an event while processing a job;
        determining if the job meets a pre-determined criterion; and
        transmitting a message to a remote destination when each of a set of
pre-determined conditions exist, the pre-determined conditions include:
        a determination that the device encountered the event while
processing the job; and
        a determination that the job met the pre-determined criterion.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Smyk	US 5,751,961	May 12, 1998
Staas	US 6,975,419	Dec. 13, 2005
Pietrowicz	US 6,978,313	Dec.20, 2005

Claims 1-8, 10-11, 13-17, and 19-24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Staas.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Staas in view of Pietrowicz.

Claims 12 and 18 stand rejected 35 U.S.C. § 103(a) as being unpatentable over Staas in view of Smyk.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Appeal Brief (filed September 14, 2007), the Reply Brief (filed February 13, 2008), and the Examiner's Answer (mailed December 13, 2007) for their respective details.

ISSUE

Appellants contend Staas does not disclose transmitting a message to a remote destination when each of a set of predetermined conditions exists, [wherein] the predetermined conditions include: a determination that the device encountered the event while processing the job; and a determination that the job met the pre-determined criterion (App. Br. 5).

The Examiner finds that Staas discloses transmitting a message to a remote destination in step 459 when an "event" occurs while processing a print job and the "request" email is in the proper format (in step 446) and when the pre-determined criterion of finding a file occurs (in step 456) (Ans. 4).

Appellants' contentions present us with the following issue:

Did Appellants show that the Examiner erred in holding that Staas teaches a method of transmitting a message wherein a message is transmitted to a remote destination when each of a set of pre-determined conditions exist including a determination that the device encountered the event while processing the job and a determination that the job met the pre-determined criterion?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of
the evidence.

The Invention

1.   According to Appellants, the invention concerns a printing
system including a computer and a printer, wherein the user requests that
when an event such as a print failure occurs that the printer system will
transmit a message to the user when pre-determined criterion are met, such
as notifying the user between the hours of business (Abstract, Fig. 7, 1:1-10,
8:8-9:6).

Staas

2.   Staas teaches a printing system and method are provided that
facilitate the mobile printing of a document. The printing system comprises
an automated print agent located in a device coupled to a network. The
printing system also comprises a network alias associated with a printer
coupled to the network, where the automated print agent acting as a network
destination for a transmitted document addressed to the network alias. The
automated print agent orchestrates the printing of the transmitted document
on the printer upon receipt of the transmitted document from a transmitting
device (Abstract).

3.   Staas teaches the automated print agent 166 waits for the return
of the rendered print job from the rendering application 169 in step 336.
When the print job has been rendered successfully, it is determined whether
there were any printing errors that occurred during the rendering operation
(step 339). Such may be the case, for example, if the rendering application
was incapable of fulfilling all of the requested print options or if the

rendering application 169 was unable to perform the rendering function at all. If there is an error in box 339, then the automated print agent 166 proceeds to box 343 in which an email message is generated that details the error related to the current print job and transmits the email message to the sender (Fig. 3B; col. 11, ll. 50-67).

      4.   Staas teaches a mobile print network that provides the user of the mobile device 153 with remote access to the document 189 that is stored on the document client 116. Specifically, the user remotely accesses the document 189 by generating a request for the document in the form of an email message using the email system 183 on the mobile device 153 that is transmitted to the document client 116. In box 446, the "request" email message is scrutinized to determine whether it is in the proper format such that the document retriever 186 recognizes the requested document, the directory location of that document in the document client 116, and any other information pertinent to the retrieval of the document 189. If the request email message is in a proper format, then the document retriever 186 proceeds to box 453 in which the request email message is parsed by the document retriever 186 to identify the file name and location of the document 189 to be retrieved in the request pay load of the request email message. Thereafter, in box 456, the document retriever 186 attempts to find the file that corresponds to the document 189 in the memory 406 (FIG. 5) of the document client 116. If the proper file can not be found in the memory 406, then the document retriever 186 proceeds to box 459 in which a reply email message is generated and transmitted to the sender of the request email message that indicates that the file can not be found (col. 7, ll. 17-24, col. 15, ll. 55-64, col. 16, ll. 3-16).

Pietrowicz

5.   Pietrowicz discloses a wireless device having the ability to receive timely/instantaneous notification of new awaiting email, network-based faxes, pages, and short text messages (col. 1, ll. 27-37).

Smyk

6.   Smyk discloses sending a message including the first hyperlink address to an ISCP in response to the selecting step (col. 4, ll. 1-9).

PRINCIPLES OF LAW

Anticipation pursuant to 35 U.S.C § 102 is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

In an appeal from a rejection for anticipation, Appellants must explain which limitations are not found in the reference. *See Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) ("[W]e expect that the Board's anticipation analysis be conducted on a limitation by limitation basis, with

specific fact findings for each *contested* limitation and satisfactory
explanations for such findings.")(emphasis added). *See also In re Kahn*, 441
F.3d 977, 985-86 (Fed. Cir. 2006)

On the issue of obviousness, the Supreme Court has stated that "the
obviousness analysis cannot be confined by a formalistic conception of the
words teaching, suggestion, and motivation." *KSR Int'l Co. v. Teleflex Inc.*,
550 U.S. 398, 419 (2007). Further, the Court stated "[t]he combination of
familiar elements according to known methods is likely to be obvious when
it does no more than yield predictable results." *Id.* at 416. "One of the ways
in which a patent's subject matter can be proved obvious is by noting that
there existed at the time of the invention a known problem for which there
was an obvious solution encompassed by the patent's claims." *Id.* at 419-
420.

The determination of obviousness must consider, *inter alia*, whether a
person of ordinary skill in the art would have been motivated to combine the
prior art to achieve the claimed invention and whether there would have
been a reasonable expectation of success in doing so. *Brown & Williamson
Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000).
Where the teachings of two or more prior art references conflict, the
Examiner must weigh the power of each reference to suggest solutions to
one of ordinary skill in the art, considering the degree to which one
reference might accurately discredit another. *In re Young*, 927 F.2d 588,
591 (Fed. Cir. 1991). If the proposed modification would render the prior
art invention being modified unsatisfactory for its intended purpose, then
there is no suggestion or motivation to make the proposed modification. *In
re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Further, our reviewing court

has held that "[a] reference may be said to teach away when a person of
ordinary skill, upon reading the reference, would be discouraged from
following the path set out in the reference, or would be led in a direction
divergent from the path that was taken by the applicant." *In re Gurley*, 27
F.3d 551, 553 (Fed. Cir. 1994); *Para-Ordnance Mfg., Inc. v. SGS Importers
Int'l, Inc.*, 73 F.3d 1085, 1090 (Fed. Cir. 1995).

ANALYSIS

Claims 1-8, 10-11, 13-17, and 19-24

We select claim 1 as representative of this group of claims, pursuant
to our authority under 37 C.F.R. § 41.37(c)(1)(vii)[2]

Claim 1 recites "transmitting a message to a remote destination when
each of a set of predetermined conditions exist, the pre-determined
conditions include: a determination that the device encountered the event
while processing the job; and a determination that the job met the pre-
determined criterion."

Appellants contend that Staas does not disclose transmitting a
message to a remote destination when each of a set of predetermined
conditions exists, [wherein] the predetermined conditions include: a
determination that the device encountered the event while processing the
job; and a determination that the job met the pre-determined criterion (App.
Br. 5). Specifically, Appellants contend that step 339 is at best a
determination as to whether a device has encountered an 'event,' the 'event'

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[2] The supposed separate arguments for claims 10, 15, and 19 are not separate
because they are the same arguments proposed for claim 1

being an error with respect to rendering the application (App. Br. 5).
Appellants contend that step 339 has nothing to do with determining if the
job meets a predetermined criterion prior to sending an email message to the
sender in step 343 (App. Br. 5). Appellants further contend that steps 446
and 463 are at best determinations as to whether an email request meets a
predetermined criterion wherein the email message is in the proper format or
an email should be forwarded (App. Br. 6). In addition, Appellants contend
that step 456 is at best a determination as to whether a device has
encountered an event that the file cannot be found (App. Br. 6).

   The Examiner finds that Staas discloses transmitting a message to a
remote destination in step 459 when an 'event' occurs (i.e., the "request"
email is in the proper format) (in step 446) and when the pre-determined
criterion of finding a file occurs (in step 456) (Ans. 4).

   We agree with the Examiner's finding that Staas does disclose
transmitting a message to a remote destination when each of a set of
predetermined conditions exists, [wherein] the predetermined conditions
including a determination that the device encountered the event while
processing the job and a determination that the job met the pre-determined
criterion. Specifically, Staas discloses that when the 'event' of the "request"
email being in the proper format (step 446) occurs and when the 'pre-
determined criterion' of finding a file (step 456) occurs, the document
retriever 186 proceeds to box 459 in which a message is generated and
transmitted to the original sender indicating that the file is not found [FF 4].
Further, we find that Staas discloses that when the 'event' of a determining
whether the print job was rendered correctly (step 336) occurs and when the
'pre-determined criterion' of the determining whether a printing error exists

(step 339) occurs, the automated print agent 166 proceeds to generate an error email message to be transmitted to the sender (step 343) [FF 3].

Therefore, we find that Staas teaches all the limitations of representative claim 1. Accordingly, we do not find error in the Examiner's rejection of claims 1-8, 10-11, 13-17, and 19-24 under 35 U.S.C. § 102(e) as anticipated by Staas, and we will sustain the rejection.

Claim 9

We affirmed *supra* the rejection of parent claim 1 under 35 U.S.C. § 102(e) as anticipated by Staas. Appellants present no separate argument for the patentability of dependent claim 9 other than claim 9 depends from claim 1. We therefore affirm the rejection of claim 9 under 35 U.S.C. § 103(a) as unpatentable over Staas in view of Pietrowicz.

Claims 12 and 18

We affirmed *supra* the rejection of parent claim 10 under 35 U.S.C. § 102(e) as anticipated by Staas. Appellants present no separate argument for the patentability of dependent claims 12 and 18 other than claims 12 and 18 depend from claims 10 and 15, respectively. We therefore affirm the rejection of claims 12 and 18 under 35 U.S.C. § 103(a) as unpatentable over Staas in view of Smyk.

CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in holding that Staas teaches a method of transmitting a message wherein a message is transmitted to a remote destination when each of a set of pre-determined conditions exist including a determination that the device encountered the

event while processing the job and a determination that the job met the pre-determined criterion.

ORDER

The Examiner's rejection of claims 1-24 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

ELD

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